REMARKS

I. Introduction

In response to the Office Action dated March 17, 2009, claims 110 and 119 have been amended. Claims 110-127 remain in the application. Re-examination and re-consideration of the application, as amended, are respectfully requested.

II. Claim Amendments

Applicants' attorney has made amendments to the claims as indicated above. Unless otherwise indicated, these amendments were made solely for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art.

III. Prior Art Rejections

In paragraphs (3)-(4) of the Office Action, claims 110-113, 117-122, and 126-127 were rejected under 35 U.S.C. §103(a) as being unpatentable over Browne et al., WO 92/22983 (Browne) in view of Wood et al., U.S. Publication No. 2002/0057893 (Wood) and Orr, U.S. Patent No. 6,760,535 (Orr). In paragraph (5) of the Office Action, claims 114-116 and 123-125 were rejected under 35 U.S.C. §103(a) as being unpatentable over Browne in view of Wood and Orr, as applied to claims 110 and 119, and further in view of Vallone et al., U.S. Patent No. 6,847,778 (Vallone).

Applicants respectfully traverse these rejections.

The Browne Reference

The Browne reference teaches a large capacity, random access, multi-source recorder player.

The Orr Reference

The Orr reference is cited in the Office Action as follows:

> FIG. 4 shows a method according to one embodiment of the present invention. At Step 202, the method begins the archiving process. The method begins at Step 202 whenever the user indicates a command to store video or audio data on the hard drive 50. At Step 204, the method determines whether the programming already resides on the hard drive. The method performs Step 204 by comparing sync pulse information belonging to the programming with similar information stored within the show tags 160 of the content database 150. If the sync pulse information of the programming matches the similar information found on the hard drive, then the

method determines that the show has already been recorded and is located on the hard drive and aborts the recording by proceeding directly to Step 228.
If the programming has not yet been recorded or otherwise is not found on the hard drive, then the method proceeds to Step 206 and determines whether the hard drive has sufficient available space to record the programming. Because it may be difficult to determine ahead of time whether content received over a data channel is too large to fit within the available space on the hard drive, Step 206 may actually be performed upon a write error to the hard drive. In the absence of such an error, the hard drive finds sufficient space to store the programming, and proceeds to Step 208. At Step 208, the method stores the programming content within a new show field that the method creates within the archive of recorded content 100 (shown in FIG. 2).

See Orr, Col. 7, lines 11-25 (emphasis added).

The Vallone Reference

The Vallone reference is cited as teaching displaying a bar overlaid on the screen when viewing a program when the program is being recorded.

The Claims Are Patentable Over the Cited References

The claims of the present invention describe methods and apparatuses for processing available content. A method of processing available content in accordance with one or more embodiments of the present invention comprises receiving the available content using one or more tuners, and performing a plurality of operations on the available content received from the one or more tuners, the plurality of operations including selecting at least one recorded event from the available content based on thumbnail, preview, or snippet, tracking a list of previously recorded programs for duplicates when a record operation for a current recording is initiated, and activating a previously selected user-identified preference to selectively terminate and erase the current recording of a program that is identified as duplicate.

Discussion

Initially, Applicants thank the Examiner for the detailed comments in response to the previously submitted arguments on pages 2 and 3 of the Office Action. Applicants response herein addresses the Examiner's concerns regarding the Orr reference reading on the claims.

As in the previous response, the Office Action admits that Browne does not teach the limitation of tracking a list of recorded programs for duplicates. Applicants agree with this characterization of Browne.

The cited references do not disclose the limitations of the present invention. Specifically, the cited references do not disclose at least the limitations of tracking a list of previously recorded programs for duplicates when a record operation for a current recording is initiated, and activating a previously selected user-identified preference to selectively terminate and erase the current recording of a program that is identified as duplicate as described in the claims of the present invention.

Orr Does Not Teach Termination and Erasure

The Office Action relies on Orr to teach the limitations of tracking a list of recorded programs for duplicates and activating a previously selected user-identified preference to selectively erase the current recording of a program. Although Applicants traverse this characterization, Applicants have amended the claims to address the objections listed in the Office Action.

The Office Action suggests that Orr's teaching of a current recording being terminated reads on the claimed limitation of "erase the current recording." Applicants have amended the claims to clarify that the user-identified preference, not listed in Orr, not only terminates recording once the current recording is identified as a duplicate, but also erases the current recording that was performed prior to the program being identified as duplicate. Thus, the characterization of Orr as reading on "erasure" of the current recording has been rendered moot with the clarification of the claim language as presented herein.

Although Wood is now cited as teaching user-identified preferences for recording, since Orr teaches that the termination of recording is automatic, and that there are no user-identified preferences taken into account, there is no possible user interaction with the Orr system to prevent recording when a duplicate is identified. See Orr, Col. 7, lines 20-25, "If the sync pulse information of the programming matches the similar information found on the hard drive, then the method determines that the show has already been recorded and is located on the hard drive and aborts the

recording by proceeding directly to Step 228 (the end process step)." Thus, regardless of what Wood teaches, Orr is incompatible with Wood because the two references teach opposing conclusions.

To establish a prima facie case of obviousness, one of the legally required criteria is that there must be some suggestion or motivation to combine or modify the references, and the combination must show all of the claim limitations. See MPEP § 2143. Applicants believe that there can be no motivation to combine or modify Orr with any reference to show at least the limitation of activating a previously selected user-identified preference to selectively terminate and erase the current recording of a program that is identified as duplicate as described in the claims of the present invention.

Orr Cannot Properly Be Combined With Nor Modified By Other References

To properly combine references, the references must be compatible with each other. Since Orr must be read as teaching automatic termination, no reference in combination with Orr can change the teaching of Orr to have Orr teach that there can be user-specified termination and erasure. Further, since Orr must be read as teaching automatic termination as admitted in the Office Action, no reference in combination with Orr can change the teaching of Orr to have Orr teach that there can be anything but automatic termination, much less user-specified termination and erasure of the current recording.

Since Orr teaches automatic termination, Orr is in conflict with any reference that teaches otherwise. Such a conflict renders combination of Orr with any such reference impossible as a matter of logic and as a matter of law. There can be no suggestion or teaching to combine references when the point of combination is directly incongruous. Further, no reference has been cited in any Office Action in the present application that teaches the limitations of the claims; even if Wood is considered to teach this limitation, it cannot be compatible with Orr's teachings of the opposite conclusion.

If Wood is characterized as teaching user-defined termination and erasure of the current recording as suggested by the Office Action, the teaching of Orr is not merely modified, it is ignored completely. Thus, any such modification of Orr cannot be properly suggested when the references are in conflict. If anything, such a direct conflict suggests that modification of any of the cited references on the point of conflict is not possible, because the modification would then be a

complete dismissal of the teachings of one of the references. Similarly, Orr cannot be combined or modified with any reference that teaches user-specified termination and erasure of the current recording.

Thus, no reference can be combined with Orr to selectively remove Orr's teaching that termination is automatic, and further, no reference can be used to modify these teachings of Orr because such a modification or combination is logically and legally inconsistent. Such references are, *de facto and de jure*, incompatible with each other, because the references teach opposing conclusions. There must be a suggestion to combine or modify the references, and the inconsistency and opposing nature of Orr with any such reference, and with the claims, on a specific issue is a direct suggestion not to combine or modify such references on the issue in conflict.

Finally, Orr cannot be selectively read to eliminate some of the teachings to render the claims obvious, i.e., Orr cannot be read as teaching anything other than automatic termination. Such a characterization is not only impermissible hindsight, it is contrary to the teachings provided by Orr and therefore logically and legally inconsistent.

As such, none of the references relied upon in this or any previous Office Actions teach the claimed invention. The Office Actions admit, at various times, that Vallone, Liebenow, Browne, Ranta, and the other ancillary references previously cited are silent on these limitations. As such, and specifically, none of the references teach nor suggest at least the limitation of activating a previously selected user-identified preference to selectively erase the current recording of a program that is identified as duplicate as recited in the claims of the present invention.

The amendments presented herein are supported by the specification as filed in at least in paragraphs [0133]-[0135].

Thus, Applicants submit that independent claims 110 and 119 are allowable over Browne, Orr, and Vallone and all other references previously cited. Further, dependent claims 111-118 and 120-127 are submitted to be allowable over the cited references in the same manner, because they are dependent on independent claims 110 and 119, respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 111-118 and 120-127 recite additional novel elements not shown by the cited references.

IV. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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